

## REMARKS

By this amendment, claims 6 and 7 have been amended to correct minor typographical and grammatical errors without changing the scope thereof and not for reasons of patentability. Claims 1-7 remain pending in this case

In the Office Action dated January 29, 2004, the Examiner rejected claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over Brooke, Jr. et al. (U.S. Patent No. 6,424,884).

The rejection of claims 1-7 under 35 U.S.C. § 103(a) is respectfully traversed for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation to modify the reference in a manner resulting in the claimed invention. See M.P.E.P. § 2143. Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02. Moreover, each of these requirements must “be found in the prior art, and not based on applicant’s disclosure.” M.P.E.P. § 2143.

Claim 1 recites a combination including, *inter alia*, an “electronic coupon,” and “displaying a redeemable representation of the at least one electronic coupon on the user device.” The Examiner admits that Brooke Jr., et al. fails to teach an “electronic coupon,” but alleges that the reference reasonably suggests the same. Office Action ¶ 2, at 3-4 (citing Brooke Jr., et al., Abstract; Fig. 5; col. 1, lines 5-12; col. 1, lines 36-45; col. 1, lines 55-65; col. 2, lines 35-67; col. 5, lines 9-20; col. 6, lines 33-67; col. 7, lines 1-67; col. 8, lines 1-67; col. 9, lines 1-30; and the whole document). Moreover, the

Examiner fails to allege that Brooke Jr., et al. teaches any of the recitations of Applicants' claim 1, instead the Examiner merely states that the reference "discloses the inherent inventive concept of claim 1." Office Action ¶ 2, at 3 (citing Brooke Jr., et al., Abstract; Fig. 1; Fig. 4; Fig. 5; col. 1, lines 5-67; col. 2, lines 1-67; col. 3, lines 1-67; col. 4, lines 1-67; col. 5, lines 1-67; col. 6, lines 1-67; col. 7, lines 1-67; col. 8, lines 1-67; and col. 9, lines 1-30). Applicants respectfully submit that the Examiner is mistaken.

First, the Examiner does not address any of the individual recitations of claim 1, other than the "electronic coupon." Office Action ¶ 2, at 3-4. Instead, the Examiner merely states that Brooke Jr., et al., "discloses the inherent inventive concept of claim 1." Id. at 3 (citing Brooke Jr., et al., Abstract; Fig. 1; Fig. 4; Fig. 5; col. 1, lines 5-67; col. 2, lines 1-67; col. 3, lines 1-67; col. 4, lines 1-67; col. 5, lines 1-67; col. 6, lines 1-67; col. 7, lines 1-67; col. 8, lines 1-67; and col. 9, lines 1-30). This is insufficient to establish a *prima facie* case of obviousness.

The Examiner is obligated to show how the prior art teaches or suggests *all claim elements* and not just the "inherent inventive concept" of Applicants' invention. See M.P.E.P. §§ 706.02(j), 2143.03. Moreover, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03. With the exception of the Examiner's incorrect allegations regarding the "electronic coupon" recitation, which are addressed *infra*, the Examiner has provided no explanation of how Brooke Jr., et al. supposedly teaches or suggests each and every recitation of claim 1. In fact, the Examiner failed to even mention any other recitations of claim 1. By merely making the vague allegation that Brooke Jr., et al. discloses the "inherent inventive concept" of claim 1 and not addressing individual claim recitations, the Examiner has

failed to meet the burden of establishing that *all claim recitations* are taught or suggested by the cited reference. See M.P.E.P. § 2143.03.

Further, the Examiner failed to support this vague allegation with citations to the reference. When issuing a rejection under 35 U.S.C. § 103, “the Examiner should set forth in the Office action . . . the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line numbers(s).” M.P.E.P. § 706.02(j), at 700-44. The Examiner failed to do so in this case. Although the Examiner does provide a citation to Brooke Jr., et al. in support of his allegation that the reference discloses the “inherent inventive concept” of Applicants’ claim 1, the citation is indiscriminate and over-inclusive. See Office Action ¶ 2, at 3.

To support his vague allegation, the Examiner cites almost the entire 14 page reference, with a few minor exceptions. Office Action ¶ 2, at 3 (citing Brooke Jr., et al., Abstract; Fig. 1; Fig. 4; Fig. 5; col. 1, lines 5-67; col. 2, lines 1-67; col. 3, lines 1-67; col. 4, lines 1-67; col. 5, lines 1-67; col. 6, lines 1-67; col. 7, lines 1-67; col. 8, lines 1-67; and col. 9, lines 1-30). In fact, the Examiner’s citation references the entire patent with the exception of three figures and the claims. Such an indiscriminate citation does not provide Applicants with any means of understanding the Examiner’s rejection or the basis for the rejection. This vague allegation and over-inclusive citation provides Applicants with no means of understanding what the Examiner considers to be the “inherent inventive concept” of claim 1, or where in Brooke Jr., et al. this “concept” is allegedly taught or suggested. Applicants respectfully remind the Examiner that “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to

respond.” M.P.E.P. § 706.02, at 700-45. The Examiner has failed to do so here.

Accordingly, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness.

Moreover, Brooke Jr., et al. fails to teach or suggest all recitations of Applicants’ claim 1. First, the reference fails to teach or suggest at least an “electronic coupon,” as recited in claim 1. Brooke Jr., et al. discloses a transponder-interrogator system where a customer can use a transponder to purchase items from a vending machine. See Brooke Jr., et al., Abstract. The transponder identifies the customer’s account, and the account is debited the purchase price of the customer’s vending machine purchase. See id. The Examiner points to the display reading “6.50 Credit” (29) that appears in Fig. 5 of Brooke Jr., et al. and states that “[t]he Examiner interprets this disclosure as suggesting ‘one electronic coupon.’” Office Action ¶ 2, at 3. This allegation is flawed.

The “6.50 Credit” display to which the Examiner refers is not a coupon. On the contrary, Brooke Jr., et al. explains that “the display 29 [in Fig. 5] is a particularly advantageous way of informing the customer C of the remaining credit amount stored within the transponder.” Brooke Jr., et al., col. 5, lines 54-57. Accordingly, as explained in the reference itself, the display referenced by the Examiner reflects the amount of money that the customer has left to spend using their transponder, it does not in any way reflect a coupon.

Furthermore, the Examiner erred in alleging that Brooke Jr., et al., reasonably suggests an “electronic coupon.” Office Action ¶ 2, at 3-4 (citing Brooke Jr., et al., Abstract; Fig. 5; col. 1, lines 5-12; col. 1, lines 36-45; col. 1, lines 55-65; col. 2, lines 35-67; col. 5, lines 9-20; col. 6, lines 33-67; col. 7, lines 1-67; col. 8, lines 1-67; col. 9, lines

1-30; and the whole document). Brooke Jr., et al. discloses two different rewards programs, an instant rewards program, and a points rewards program. See Brooke Jr., et al., col. 8, line 29 to col. 9, line 3. Neither of these rewards programs, however, involve an “electronic coupon.” With the instant rewards program in Brooke Jr., et al., the customer could receive a reduced price on one or more of the items purchased. Brooke Jr., et al., col. 8, lines 36-38. This is not a coupon. The instant rewards program in Brooke Jr., et al. is not providing the customers with a *coupon* for reduced prices on certain items. Instead, the price of the items are automatically reduced when purchased. See id. Further, Brooke Jr., et al. is unclear as to whether the customer even realizes that they have received a reduced price. The instant rewards program in Brooke Jr., et al., also may reward the customer with a prize such as a free T-shirt, a free hat, or an entry to win a free vacation. Brooke Jr., et al., col. 8, lines 40-52. Again, these prizes are not coupons. Similar to the reduced price reward, this rewards system in Brooke Jr., et al. is not providing the customers with a *coupon* for prizes or free items. Instead, it is providing customers with the free item itself. See id.

Likewise, the points reward program does not involve coupons. As the name of the program suggests, the points reward program in Brooke Jr., et al. rewards the customer with points for each purchase, it does not provide the customer with coupons. Brooke Jr., et al., col. 8, lines 53-65. Furthermore, even if these points were interpreted as being coupons, which they are not, the points are merely awarded with a purchase; they are not selected “based on the determined profile of the user,” as recited in claim 1.

Accordingly, Brooke Jr., et al. fails to teach or suggest at least an “electronic coupon,” as recited in Applicants’ claim 1.

Moreover, Brooke Jr., et al. fails to teach or suggest at least “displaying a redeemable representation of the at least one electronic coupon on the user device,” as recited in claim 1. As previously explained, the rewards provided in Brooke Jr., et al. are not electronic coupons. But even if the prizes and points awarded in Brooke Jr., et al. were interpreted as being coupons, which they are not, none of these prizes are “display[ed] . . . on the user device,” as recited in claim 1. First, many of the rewards disclosed in Brooke Jr., et al., such as a free T-shirt, are incapable of being displayed in any medium, let alone a user device, as claimed in the present invention. Further, the device used by the customer in Brooke Jr., et al. is a transponder, which the reference describes as being embedded in items “such as a key chain attachment, a fob, a watch, a ring, a necklace locket, other jewelry, a small flashlight, [or] a pocket knife.” Brooke Jr., et al., col. 7, lines 10-16. None of these items have the capability to display anything, let alone the rewards provided. Accordingly, Brooke Jr., et al. fails to teach or suggest at least “displaying a redeemable representation of the at least one electronic coupon on the user device,” as recited in Applicants’ claim 1.

Finally, the Examiner stated that “it would have been obvious to a person of ordinary skill in the art at the time of the invention that the cited disclosure of Brooke would have been selected in accordance with showing the electronic coupon features of the current invention because selection of such features would have provided means for *‘[tracking] purchasing habits of a customer . . . and reward[ing] purchasers with incentives’* such as coupons.” Office Action ¶ 2, at 4 (emphasis in original) (first

alteration in original). This statement, however, is insufficient to establish a *prima facie* case of obviousness.

First, the Examiner has failed to make clear how Brooke Jr., et al. could to be modified to arrive at the present claimed invention. See M.P.E.P. § 706.02(j), at 700-45. Furthermore, it is established that “[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references.” M.P.E.P. § 2143.01, at 2100-125 (citing Al-Site Corp. v. VSI Int’l Inc., 174 F.3d 1308 (Fed. Cir. 1999)).

Moreover, “[a]lthough a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’” Id. § 2143.01, at 2100-126 (quoting In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1992)) (emphasis added). There is no such suggestion in Brooke Jr., et al. In fact, as previously explained many features of the system disclosed in Brooke Jr., et al. would have made such a modification unfeasible (e.g. the nature of the user device, *i.e.* the transponder).

Further, the Examiner’s allegation of obviousness is based on features not recited in claim 1. As previously mentioned, the Examiner alleges that it would have been obvious that Brooke Jr., et al. shows “the electronic coupon features of the current invention because selection of such features would have provided means for ‘*[tracking] purchasing habits of a customer . . . and reward[ing] purchasers with incentives*’ such as coupons.” Office Action ¶ 2, at 4 (emphasis in original) (first alteration in original). Tracking purchasing habits of a customer and rewarding purchasers with incentives, however, are not recited in claim 1. While this is not to say that embodiments of the present claimed invention would not achieve these objectives, the Examiner is charged

with establishing that the *claimed* invention is obvious, and claim 1 does not recite the features alleged by the Examiner as being obvious.

For at least the foregoing reasons, claim 1 is patentable over Brooke Jr., et al. Applicants therefore respectfully request that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn and the claim allowed.

Claims 2-5 depend upon allowable claim 1. As explained above, claim 1 is patentable over Brooke Jr., et al. Accordingly, claims 2-5 are patentable over Brooke Jr., et al. at least by reason of their dependency from allowable claim 1. Moreover, as with claim 1, the Examiner has failed to address the individual recitations of claims 2-5 and has provided an over-expansive, indiscriminate citation to Brooke Jr., et al. in support of an allegation of obviousness. See Office Action ¶ 2, at 4 (citing Brooke Jr., et al., Abstract; Fig. 1; Fig. 4; Fig. 5; col. 1, lines 5-67; col. 2, lines 1-67; col. 3, lines 1-67; col. 4, lines 1-67; col. 5, lines 1-67; col. 6, lines 1-67; col. 7, lines 1-67; col. 8, lines 1-67; and col. 9, lines 1-30). Accordingly, as discussed in detail with respect to claim 1, the Examiner has failed to provide Applicants with a fair opportunity to respond because the Examiner has not given Applicants any means of understanding the rejection of claims 2-5 or the basis for the rejection. Applicants therefore request that the rejection of claims 2-5 be withdrawn and the claims allowed.

Claim 6 recites a combination including, *inter alia*, an “electronic coupon,” and “storing a plurality of electronic coupons.” In rejecting claim 6, the Examiner merely relies on his rejection of claim 1 and does not address any recitations of claim 6. Therefore, as discussed in detail with respect to claim 1, the Examiner has failed to provide Applicants with a fair opportunity to respond because the Examiner has not



given Applicants any means of understanding the rejection of claim 6 or the basis for the rejection.

Further, Brooke Jr., et al. fails to teach or suggest each and every recitation of claim 6. As explained above with respect to claim 1, Brooke Jr., et al. fails to teach or suggest at least an “electronic coupon.” Moreover, even if the rewards provided in Brooke Jr., et al. were interpreted as being coupons, which they are not, the reference fails to teach or suggest at least “storing a plurality of electronic coupons,” as recited in Applicants’ claim 6. There is no disclosure anywhere in Brooke Jr., et al. regarding storing any of the rewards provided. In fact, many of the rewards disclosed in Brooke Jr., et al., e.g. reduced prices and points, are intangible items that cannot be stored. Accordingly, Brooke Jr., et al. fails to teach or suggest at least “storing a plurality of electronic coupons,” as recited in claim 6.

Finally, as explained with respect to claim 1, there is no motivation to modify Brooke Jr., et al. in a manner resulting in the present claimed invention. Accordingly, for at least the foregoing reasons, claim 6 is patentable over Brooke Jr., et al. Applicants therefore respectfully request that the rejection of claim 6 under 35 U.S.C. §103(a) be withdrawn and the claim allowed.

Claim 7, while of different scope, contains recitations similar to those of claim 1; for example an “electronic coupon,” and “displaying a redeemable representation of the at least one electronic coupon on the user device.” In rejecting claim 7, the Examiner merely relies on his rejection of claim 1 and does not address any recitations of claim 7. Therefore, as discussed in detail with respect to claim 1, the Examiner has failed to provide Applicants with a fair opportunity to respond because the Examiner has not

given Applicants any means of understanding the rejection of claim 7 or the basis for the rejection. Furthermore, as explained above with respect to claim 1, Brooke Jr., et al. fails to teach or suggest at least an "electronic coupon," and "displaying a redeemable representation of the at least one electronic coupon on the user device," as recited in claim 7.

Moreover, as explained with respect to claim 1, there is no motivation to modify Brooke Jr., et al. in a manner resulting in the present claimed invention. Accordingly, for at least the foregoing reasons, claim 7 is patentable over Brooke Jr., et al. Applicants therefore respectfully request that the rejection of claim 7 under 35 U.S.C. §103(a) be withdrawn and the claim allowed.

Should the Examiner continue to reject the claims, it is submitted that the next Office Action should be made nonfinal, for the reasons given above.

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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